

Customer No.: 31561  
Application No.: 10/063,793  
Docket No.: 8192-US-PA

### REMARKS

#### Present Status of the Application

The Office Action rejects claims 1, 3-8, 10-15, 18-25 and 28-30 under 35 U.S.C. 103(a) as being unpatentable over Wachtler et al. (US 6,274,391 B1) in view of Viswanathan et al. (US 6,724,079 B2). Further, the Office Action also rejects claims 1-30 under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. (US 2003/0134455 A1) in view of Wachtler et al. and Viswanathan et al., in conjunction with the Accuratus data sheets on alumina and aluminum nitride. Applicants cannot agree with the rejections and reconsideration of those claims is respectfully requested.

#### Discussion of Office Action Rejections

The Office Action rejects claims 1, 3-8, 10-15, 18-25 and 28-30 under 35 U.S.C. 103(a) as being unpatentable over Wachtler et al. (US 6,274,391 B1) in view of Viswanathan et al. (US 6,724,079 B2).

First of all, as pointed out by the Office Action, Wachtler et al. does not teach that substrate comprises an internal circuit (page 4, lines 9-10). Further, *the Office Action asserts cover 140 in the Viswanathan as the substrate*. Applicants, however, cannot agree with the assertion for the reasons set forth below:

As mentioned in column 4, lines 10-30 of Viswanathan, components and processes such as LTCC and HTCC of the cover 140 are provided. Further, components of the supporting substrate are provided such as in column 2, lines 64-65. It is obvious that the cover and the supporting

Customer No.: 31561  
Application No.: 10/063,793  
Docket No.: 8192-US-PA

substrate are different from each other either in process or the actual position in the circuit. Moreover, the cover 140 has different function from the supporting substrate. Further, throughout the Viswanathan, the internal circuit merely provided in the cover 140. Accordingly, it is obvious that Viswanathan only suggests to put the internal circuit in the cover 140, and, since the cover 140 is different from the supporting substrate, it is a reasonable assertion that Viswanathan never thinks that the internal circuit can be implemented into the supporting substrate. In other words, although an internal circuit is provided in the cover, Viswanathan never suggests that the internal circuit can be applied in the supporting substrate.

Further, because the substrate in the present application and the supporting substrate belong to an analogous field, those skilled in the art would not be taught to add an internal circuit in the substrate by referring to Viswanathan because Viswanathan never taught that.

Accordingly, those skilled in the art do not have motivation to combine Wachtler and Viswanathan because the substrate is totally different from the cover. Further, even combined, they cannot achieve the technique feature of "the substrate comprises an internal circuit" as claimed in the independent claims because both of Wachtler and Viswanathan do not suggest the same thing.

Accordingly, independent claims 1, 8, 15 and 23 are patentable over Wachtler in view of Viswanathan for at least the reasons set forth above. Further, dependent claims 2-7, 9-14, 16-22 and 24-30 are patentable over Wachtler in view of Viswanathan as a matter of law since their dependent claims are patentable over the cited references.

Customer No.: 31561  
Application No.: 10/063,793  
Docket No.: 8192-US-PA

The Office Action also rejects claims 1-30 under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. (US 2003/0134455 A1) in view of Wachtler et al. and Viswanathan et al., in conjunction with the Accuratus data sheets on alumina and aluminum nitride. Applicant respectfully traverses the rejection for the reasons set forth below.

Cheng and Viswanathan do not belong to analogous field. Although both of Cheng and Viswanathan are used to produce a passive device, they are different in processing procedures. In the present application and Cheng, firstly, a cavity is formed in the substrate, thereafter the chip is set in the cavity, and several layers are generated one by one over the chip to form the passive device. However, in Viswanathan, the cover 140, substrate 110 and the electronic device 130 are deemed as three different components and are made individually. The three components are combined together to form the passive device. It is obvious that Cheng and Viswanathan use different processing procedures to produce a passive device. For different processing procedures, the way to produce a passive device and the difficulty encountered in producing a passive device are totally different from each other. Accordingly, those skilled in the art would not refer to Cheng and Viswanathan at the same time because not only they are in non-analogous field but also they face different problems that needs to be solved.

Accordingly, combination of Cheng and Viswanathan is improper, or, in other words, those skilled in the art would not have motivation to combine the two cited references.

Accordingly, claims 1-30 are patentable over Cheng in view of Wachtler and Viswanathan, in conjunction with the Accuratus data sheets on alumina and aluminum nitride.

Customer No.: 31561  
Application No.: 10/063,793  
Docket No.: 8192-US-PA

### CONCLUSION

For at least the foregoing reasons, it is believed that all the pending claims 1-30 of the invention patently define over the prior art and are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

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Respectfully submitted,

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